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09/940,590	08/29/2001	Masaharu Matsumoto	2001_1207A	5025

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EXAMINER	
FLANDERS, ANDREW C	

ART UNIT	PAPER NUMBER
2615	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/940,590	MATSUMOTO ET AL.	
	Examiner	Art Unit	
	ANDREW C. FLANDERS	2615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 May 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *8-10,12 and 21-24* is/are allowed.

6)☒ Claim(s) *1-7,11,13-20 and 25-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *29 August 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 30 May 2008 have been fully considered but they are not persuasive.

Applicant alleges:

> In the Office Action, claims 34 and 35 have been rejected under 35 U.S.C. 101 for allegedly being directed to non-statutory subject matter. Specifically, the Examiner alleged that claims 34 and 35 are directed to programs that do not fall within one of the four statutory categories. Accordingly, the Applicants have herein amended claims 34 and 35 to indicate that the programs are "stored on a computer-readable medium." Accordingly, withdrawal of the rejection to claims 34 and 35 under 35 U.S.C. 101 is respectfully requested.

Examiner respectfully disagrees. Claims 34 and 35 are still directed to the computer program itself, rather than the medium. This is indicated by the language of the claim itself starting with the “distribution program." Additionally, these programs are disclosed as being signals in the specification. Thus, the program can be considered nothing more than a signal. Signals are non statutory as they do not fall within one of the four statutory categories.

Applicant further alleges:

> “Thus, although Jakuboski discloses the receipt of software, the reference fails to disclose or suggest that the software is written into the memory 142. Accordingly, Jakuboski fails to disclose at least the features

> of the acquisition device and the audio reproduction device of claims 1, 13, 25, 28 and 30-35."

Examiner respectfully disagrees. Jakubowski discloses, at the minimum, the ability to download software modules as shown in the prior rejection; OA page 3 "the distribution can distribute software; col. 3 lines 40 – 45." Jakubowski also discloses a memory which stores software as shown in Fig. 1. Jakubowski anticipates that one can download software. While not explicitly disclosed, Jakubowski needs to store this software somewhere. The memory 142 is the only disclosed memory where this is possible. Thus, it is implicit that the download programs are stored within this memory.

Applicant further alleges:

> In the Office Action, the Examiner relied on Chea for disclosing all the features recited in dependent claim 2. Specifically, the Examiner relied on column 4 of Chea. However, the Applicants maintain that Chea discloses that audio data files and associated decoder files are loaded onto memory card 32 using a PC or other similar device using music management software. As noted above, the audio data files and the decoder files are associated with each other before hand, and the music management software selects a decoder in accordance with this association. Therefore, Chea fails to disclose or suggest at least the claimed detection module of claim 2.
>
> Specifically, as recited in claim 2, the detection module detects the decode program. Therefore, encoded audio data can be properly decoded regardless of which of the different compression-encode formats was used for generating the encoded audio data. No such feature is believed to be disclosed or suggested by Chea. Based on the foregoing, dependent claim 2 is also believed to be distinguished from the cited prior art based on its own merit.

Examiner respectfully disagrees. Applicant alleges that Chea fails to disclose the claimed detection module. In the previous office action, Fig. 4 shows a determination

step regarding the format of a content, 140 of Fig. 4. This determination then either continues as usual if the format is the same, or loads a corresponding decoder into RAM in 130 if the format has changed. These components perform the same operations as the detection module as claimed in claim 2.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 34 and 35 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 34 and 35 are directed to a program. A program does not fall within one of the four statutory categories.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 13, 14, 25 and 28 – 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jakubowski (U.S. Patent 7,054,443) in view of Chea (U.S. Patent 7,076,432).

Regarding **Claim 1**, Jakubowski discloses:

A distribution system that distributes a program for decoding encoded audio data (the distribution can distribute software; col. 3 lines 40 – 45; one type of software is a software package that evaluates protected goods; col. 4 element 152; since the system can distribute software, and the disclosure also discloses a separate software program, the limitation is met), comprising:

a distribution server device which sends the program (102);

a removable memory unit which has an area for storing one or more programs (142);

an acquisition device which, being connected to the distribution server device via a network and loaded with the removable memory unit, acquires the program from the distribution server device and stores the program into the removable memory unit (106).

Jakubowski does not explicitly disclose an audio reproduction device which, being loaded with the removable memory unit storing the program, decodes the encoded audio data using the program, and outputs sounds.

Chea discloses a portable audio player with various play back audio in various formats. Modifying the receive device of Jakubowski (104) to operate as the playback device of Chea discloses:

an audio reproduction device (Figs 1 – 3 of Chea) which, being loaded with the removable memory unit storing the program (the evaluator 152 of Jakubowski as modified by the decoder files of Chea col. 4), decodes the encoded audio data using the program, and outputs sounds (Playback as disclosed by Chea).

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the audio player of Chea to operate as the playback device of Jakubowski. It would have been a simple substitution of one known element (Chea's device) for another (Jakubowski's client) to obtain predictable results. Jakubowski acknowledges that the client may be implemented as a variety of device's (col. 4 lines 25 – 30) one of them being an audio appliance. Chea discloses a typical audio appliance. Substituting this device into Jakubowski would have been produced results that were reasonably predictable. Licensing

Regarding **Claim 2**, in addition to the elements stated in claim 1, the combination further discloses:

wherein the removable memory unit stores one or more programs which are each used for decoding encoded audio data of a different type (i.e. the decoder files stored in Chea; col. 4),

the audio reproduction device stores a detection module beforehand, the detection module being a program module used for detecting a type of the encoded audio data (i.e. music management software, which uses the decoder files; col. 4; and determines which decoder to use to play back the file; fig 4), and

the audio reproduction device detects the type of the encoded audio data using the detection module, reads the program for decoding encoded audio data of the detected type from the removable memory unit, and decodes the encoded audio data using the read program (fig. 4 showing playback after attribute determination and loading the corresponding decoders into the music management software).

Regarding **Claim 28**, in addition to the elements stated above, the combination further discloses:

a non-authentication storage area which stores a program for decoding encoded audio data (i.e. storage area for the decoder files of Chea); and

an authentication storage area which stores permission information indicating that the program is permitted to use, in correspondence with the program (i.e. storage area for the evaluator program in Jakubowski),

wherein an access device is allowed to access the authentication storage area only when the access device has succeeded in mutual device authentication with the removable memory medium (decoding only occurs when the evaluator determines the conditions for licensing have been met; Jakubowski).

Regarding **Claim 29**, in addition to the elements stated in claim 28, the combination further discloses:

wherein the non-authentication storage area also stores a detection module used for detecting a type of the encoded audio data (i.e. the area of memory that stores the

music management software, which uses the decoder files; col. 4; and determines which decoder to use to play back the file; fig 4)

Claims 13, 14, 25 and 30 – 35 are met by the rejections above of Jakubowski in view of Chea.

Claims 3 – 7, 11, 15 – 20, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jakubowski (U.S. Patent 7,054,443) in view of Chea (U.S. Patent 7,076,432) and in further view of Lipscomb (U.S. Patent 7,020,704).

Regarding **Claim 3**, the combination fails to explicitly disclose the limitations of claim 3. Lipscomb discloses a client server system with DRM features. Applying Lipscomb to the combination discloses:

wherein the distribution server device sends permission information which indicates that the program is permitted to use, in correspondence with the program (i.e. tracking and synchronizing licensing rights between the portal(server) and user device; col. 10),

the acquisition device acquires the permission information, and stores the permission information into the removable memory unit in correspondence with the program (i.e. storing the licensing information; various passages in cols. 10 – 12; one example in these passages being the watermark sent), and

the audio reproduction device decodes the encoded audio data using the program, only when the permission information corresponding to the program is stored in the removable memory unit (i.e. playback in Chea is enabled with the pre-negotiated rules in Lipscomb are satisfied; cols. 9 – 12).

Regarding **Claim 4**, in addition to the elements stated above regarding claim 3, the combination further discloses:

wherein the distribution server device sends condition information which shows a condition for using the program, in correspondence with the program (i.e. the rights management rules can provide for a limited number of plays or limited number of days; col. 10 of Lipbscomb),

the acquisition device acquires the condition information, and stores the condition information into the removable memory unit in correspondence with the program (i.e. downloading the 'licensed' assets; col. 10; these assets including the limited play information), and

the audio reproduction device judges whether the program is permitted to use based on the condition shown by the condition information stored in the removable memory unit, and decodes the encoded audio data using the program only when the program is judged as being permitted to use (depending on the limitation instituted by the DRM, the media owner will only be able to play back the if the licensing arrangement is satisfied; cols. 9 - 12).

Regarding **Claim 5**, in addition to the elements stated above regarding claim 4, the combination further discloses:

wherein the condition information is period information that limits a period during which the program is permitted to use (i.e. limited number of days col. 11),

the distribution server device sends the period information (i.e. downloading the 'licensed' assets; col. 10; these assets including the limited play information,

the acquisition device acquires the period information and stores the period information into the removable memory unit (storing the licensed assets as well as the pre-negotiated rules; cols. 9 – 12), and

the audio reproduction device judges that the program is permitted to use, if current date and time is within the period shown by the period information (depending on the limitation instituted by the DRM, the media owner will only be able to play back the if the licensing arrangement is satisfied; cols. 9 – 12).

Regarding **Claim 6**, in addition to the elements stated above regarding claim 5, the combination further discloses:

wherein the condition information is number (i.e. limited number of plays; col. 11)

information which limits a remaining number of times the program is permitted to use (i.e. limited number of plays; col. 11),

the distribution server device sends the number information (sending the licensed assets' cols. 9 – 12),

the acquisition device acquires the number information and stores the number information into the removable memory unit (storing the licensed assets as well as the pre-negotiated rules; cols. 9 – 12, and

the audio reproduction device judges that the program is permitted to use, if the number shown by the number information is not smaller than I, the number being decreased by 1 each time the audio reproduction device decodes encoded audio data using the program (depending on the limitation instituted by the DRM, the media owner will only be able to play back the if the licensing arrangement is satisfied; cols. 9 – 12).

Regarding **Claim 7**, in addition to the elements stated above regarding claim 3, the combination fails to explicitly disclose wherein the distribution server device generates a user identifier which identifies a user of the audio reproduction device, stores the generated user identifier, and also sends the generated user identifier, and

the acquisition device acquires the user identifier and stores the user identifier into the removable memory unit.

However, the combination discloses many identifiers that are stored by the user device in cols 10 – 12 (i.e. usernames/pass/watermarks/serial numbers). These identifiers are either generated by the user, or written at the time of manufacturing. Generating these numbers via the server would have been obvious to one of ordinary skill in the art. Altering the generation wouldn't alter the device in such a way to render it inoperable. The alteration is small in comparison to the entire system. Switching the

generation does not produce any new or unexpected result and would have been obvious to try.

Regarding **Claim 11**, in addition to the elements stated above regarding claim 3, the combination further discloses:

an account server device, wherein the acquisition device is connected to the account server device via the network, and sends payment information to the account server device, the payment information indicating that payment has been made for the acquisition of the program (the business model for the device allows customers to purchase media for appropriate fees; while not explicitly disclosing a server; payments are accepted via the network as shown in Fig. 10 and the description in col. 11 - 12. Fig. 10 shows a check out button; thus it is obvious a server is included for processing payments),

the account server device is connected to the distribution server device via the network, and when receiving the payment information, sends confirmation information to the distribution server device, the confirmation information confirming that the payment has been made for the acquisition of the program (i.e. a receipt of payment, typically given while not disclosed, is obvious after a user performs the check out function in Fig. 10, and

the distribution server device sends the program, when receiving the confirmation information (i.e. sending the media when the licensing has been satisfied; cols. 10 – 12).

Regarding **Claim 16**, in addition to the elements stated above regarding claim 15, the combination further discloses:

A displaying unit operable to display a message indicating that the program is prohibited to use, when the permission information is not stored in the removable memory unit (i.e. the display taught by Chea; Lipscomb not playing media if the rights are not met; a message displayed is not taught but obvious in view of the references as it is desirable to alert a user of errors in playback.)

Regarding **Claim 20**, in addition to the elements stated above regarding claim 15, the combination further discloses:

a displaying unit operable to display an identifier that identifies the program which is permitted to use, based on the permission information stored in the removable memory unit unit (i.e. the display taught by Chea; Lipscomb playing media if the rights are met; a message displayed is not taught but obvious in view of the references as it is desirable to alert a user of playback states.)

Claims 15, 17 – 19 and 26, 27 are met by the rejections above of Jakubowski in view of Chea and in further view of Lipscomb.

Allowable Subject Matter

Claims 8 – 10, 12 and 21 – 24 are allowed as the combination does not anticipate or make obvious the claimed limitations of claims 8 – 10, 12 and 21 – 24.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW C. FLANDERS whose telephone number is (571)272-7516. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Suhan Ni can be reached on (571) 272-7505. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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